IV. REMARKS/ARGUMENTS

These Remarks are in response to the Office Action mailed October 4, 2004. No fee is due for the addition of any new claims.

Claims 1-23 were pending in the Application prior to the outstanding Office Action. The Office Action rejected claims 1-23. The present response amends claims 1, 20, and 22, leaving for the Examiner's present consideration claims 1-23. Reconsideration of the rejections is respectfully requested.

I. Amendment to Title

The Office Action objected to the title of the invention as not descriptive. The title has been amended to remove the Examiner's objection.

II. Amendments to the Specification

Paragraphs [0011] and [0013] have been amended to refer to "the command instruction" instead of "the step of obtaining" in order to maintain consistency with the similar amendment to claim 1 discussed below.

III. Claim Rejections Under 35 U.S.C. § 112

Although no objection was raised to Claim 3 on grounds of indefiniteness under 35 U.S.C. § 112, Applicants have amended claim 3 to correct the reference in the last element to refer to "representative image" instead of "representative," thereby making the claim more fully consistent with the specification, and promoting greater definiteness.

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Claim 1 was rejected under 35 U.S.C. § 112 ¶2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants therefore amend claim 1 to replace the reference to "the step of obtaining" with "the command instruction." As mentioned above, equivalent amendments have been made to the specification.

Claims 20 and 22 were rejected under 35 U.S.C. § 112 ¶2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants therefore amend claims 20 and 22 to replace the references to "a parameter, a value associated with the parameter" with "at least one parameter that indicates information to be delivered, a value associated with the at least one parameter."

IV. Claim Rejections Under 35 U.S.C. § 102(e)

As preliminary matters, the Office Action does not contain any grounds for rejection of claim 14. Nor does the Office Action contain any detailed reasons supporting rejection of claim 14. However, claim 14 is listed as rejected, along with all other claims, in the Office Action Summary. The additional limitations of claim 14, relating to a return address, are not contained in any other claim, and therefore are not addressed anywhere in the Office Action. Applicants therefore assume and will proceed under the assumption that the Office Action intends to include claim 14 among the rejected claims based on the reasons for rejection of the underlying independent claim 11. Secondly, Applicants assume that the numerous references in the Office Action to figures or to column and line numbers of an unspecified source intend to refer to *Tilden, Jr.* Applicants respectfully

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request that the Examiner inform them by telephone at the phone number given below if they are mistaken in one or more of these assumptions.

Claims 1-3, 8, 9, 13, and 15-23 were rejected under 35 U.S.C. '102(e) as being anticipated by Tilden, Jr. (U.S. Patent 6,449,635; hereafter, *Tilden, Jr.*). It is respectfully submitted that *Tilden, Jr.* does not anticipate the invention as claimed. *Tilden, Jr.* teaches a data distribution system for deploying email using short email messages, which when opened call a large body of information from a server computer that includes a script program. The server computer and script program are necessarily under the control of the entity operating the invention. The stated principal application of the invention is the bulk sending of and subsequent user receipt verification of commercial electronic mail messages, commonly known as "spam." By contrast, the current claims describe an invention that allows a user to enhance the functionality of an email message by integrating the computation and functionality available through the Internet and elsewhere with a user's email message transmission.

Claims 1 and 17 were rejected as unpatentable over *Tilden, Jr.* Applicants respectfully traverse the rejections. The current claims, unlike *Tilden, Jr.*, are not limited to making use of information on a user's website. Rather, the current claims allow integration of functions and capabilities available on *any* website located *anywhere* in the world, with no limitation on the identity of the website's operator. Moreover, the current claims do not describe merely a method for increasing the size of email advertisements following their receipt and tracking their receipt. By contrast, the current claims describe a robust method, article of manufacture, and apparatus for powerfully leveraging the virtually limitless capabilities of the Internet by permitting a user to avoid having to

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separately, manually travel to Internet sites to perform steps involved in composing an electronic mail message. The desired steps involving Internet access are automatically performed following receipt of the message according to the claims.

Tilden, Jr. fails to disclose all of the limitations of claims 1 and 17. Claims 2-10 and 18-23 each ultimately depend from one of these independent claims and are believed patentable for at least the same reasons as the independent claims and because of additional limitations of these claims.

Accordingly, claims 1-10 and 17-23 are believed patentable over the cited reference and withdrawal of the rejections is respectfully requested.

V.   **Claim Rejections Under 35 U.S.C. § 103(a)**

Claims 4-7 and 11-12 were rejected under 35 U.S.C. § 103(a) as being disclosed by *Tilden, Jr.* in view of Borenstein (WO 92/22033; hereafter, "Borenstein"). Claim 10 was rejected under 35 U.S.C. § 103(a) as being disclosed by *Tilden, Jr.* in view of Borenstein and further in view of Richard (U.S. Patent 6,728,711; hereafter, *Richard*). Applicants respectfully traverse the rejections of claims 4, 6, 10, and 11-12.

The references cited in the Office Action, including *Tilden, Jr.* and Borenstein, either singly or in combination, fail to disclose all of the limitations of claims 4, 6, and 11-12. The references cited in the Office Action, including *Tilden, Jr.*, Borenstein, and *Richard*, either singly or in combination, also fail to disclose all of the limitations of claim 10.

With regard to claims 4 and 10, the Office Action concedes (p. 7, 2nd paragraph and p. 11, 1st paragraph) that *Tilden, Jr.* does not disclose determining an application

provider. However, the Office Action states (p. 7, 2nd paragraph and p. 11, 1st paragraph) that Borenstein discloses determining an application provider at "page 4, lines 1-6." The cited section of Borenstein discloses that an active message can be received at one organizational center for asking a few questions to collect certain information, after which the active message sends itself off to the next link in the organizational chain. As examples, Borenstein discloses that expense vouchers, purchase orders, and insurance claims can be processed in this manner. Contrary to the suggestion of the Office Action, the cited section of Borenstein makes no disclosure regarding determining an application provider.

With regard to claim 6, the Office Action states (p. 8, 3rd paragraph) that *Tilden, Jr.* (col. 6, lines 18-25) teaches a script program which contains a command which performs a task in response to a user's request. However, the cited section of *Tilden, Jr.* discloses that program control is passed to a test task step following the processing tracking step, looping thereat until information passed from the subscriber computer is received, whereupon a transaction task is performed in response to the user's request in a do task step. The cited section of *Tilden, Jr.* further disclose that the task step could be filling of an order for products or services, or anything else that would be an appropriate response to the user input. Contrary to the suggestion of the Office Action, this section discloses nothing regarding a script program containing a command that performs a task in response to a user's request.

With regard to claims 11-12, the Office Action concedes (p. 9, 4th paragraph and p. 10, 2nd paragraph) that *Tilden, Jr.* does not disclose alteration of the destination address. However, the Office Action states (p. 9, 4th paragraph and p. 10, 2nd paragraph)

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that Borenstein (page 4, lines 13-17) discloses alteration of the destination address. However, the cited section of Borenstein discloses that even more insidiously, one could create a mail based virus that could bring any computer network to its knees, simply by mailing out two copies of itself every time it is received by a recipient. Contrary to the suggestion of the Office Action, this section discloses nothing regarding alteration of the destination address.

Claims 12-16 each ultimately depend from independent claim 11 and are believed patentable for at least the same reasons as the independent claims and because of additional limitations of these claims.

Accordingly, claims 11-16 are believed patentable over the cited references and withdrawal of the rejections is respectfully requested.
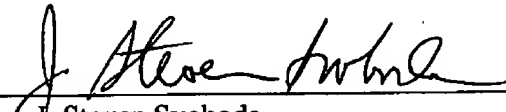
VI. Conclusion

The references cited by the Examiner but not relied upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all remaining claims, as amended in the subject patent application, should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of the patent.

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The Commissioner is authorized to charge any underpayment or credit any

overpayment to Deposit Account No. 24-0037 for any matter in connection with this

response, including any fee for extension of time, which may be required.

Respectfully submitted,

Dated: ___12/30/04___   By: _____
                                        J. Steven Svoboda
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